IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

    Robert E. Haines

Serial No.: 09/976,715

Filed: October 11, 2001

Group Art Unit: 2143

Examiner: England, David

Docket No. 10007587-1

For: **Hardcopy Output Engine Discovery Method and Apparatus**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed November 21, 2006 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to points made in Applicant's Appeal Brief. Applicant addresses those responses in the following.

A. The Meaning of "Network"

In the Examiner's Answer, the Examiner first argues that a peripheral device connected to a host computer as in the Zintel reference constitutes a "network." *Examiner's Answer*, pages 10-11. For support, the Examiner identifies a definition from webopeida.com that states that "network" means a "group of two or more computer systems linked together". As a first, matter, Applicant notes that a peripheral device is not a "computer system." Instead, a peripheral device is simply a device that is used in conjunction with a computer. As defined by webopedia.com, a "peripheral device" is:

> A computer device, such as a CD-ROM drive or printer, that is not part of the essential computer, i.e., the memory and microprocessor. Peripheral devices can be external -- such as a mouse, keyboard, printer, monitor, external Zip drive or scanner -- or internal, such as a CD-ROM drive, CD-R drive or internal modem. Internal peripheral devices are often referred to as integrated peripherals. Also see I/O.

Therefore, a "peripheral device" is simply a device that is connected to a host computer and used in conjunction with that computer.

As a further matter, although webopedia.com does broadly describe a "network" as being a "group of two or more computer systems linked together," the definition does not stop there. The entire definition provided by webopedia.com is as follows:

(n.) A group of two or more computer systems linked together. There are many types of computer networks, including:

• local-area networks (LANs): The computers are geographically close together (that is, in the same building).

• wide-area networks (WANs): The computers are farther apart and are connected by telephone lines or radio waves.

• campus-area networks (CANs): The computers are within a limited geographic area, such as a campus or military base.

• metropolitan-area networks MANs): A data network designed for a town or city.

• home-area networks (HANs): A network contained within a user's home that connects a person's digital devices.

In addition to these types, the following characteristics are also used to categorize different types of networks:

• topology: The geometric arrangement of a computer system. Common topologies include a bus, star, and ring. See the Network topology diagrams in the Quick Reference section of Webopedia.

• protocol: The protocol defines a common set of rules and signals that computers on the network use to communicate. One of the most popular protocols for LANs is called Ethernet. Another popular LAN protocol for PCs is the IBM token-ring network .

• architecture: Networks can be broadly classified as using either a peer-to-peer or client/server architecture.

Computers on a network are sometimes called nodes. Computers and devices that allocate resources for a network are called servers.

Clearly, the above definition is not simply describing the connection of a peripheral device to a host computer. Instead, it is clear that the term "network" is used to identify local area networks (LANs), wide area networks (WANs), and the like which are used for computer-to-computer connectivity in situations in which those computers are *not* directly connected to each other. This is why the definition references concepts such as network topology, protocol, and architecture.

Finally, Applicant asserts that the Examiner's interpretation of the term "network" is clearly unwarranted and improper. By now the meaning of the term "network" is well known to persons having ordinary skill in the art, and even to the general public, as meaning a computer network such as a LAN, a WAN, or the Internet. None of those people would reasonably consider a peripheral device connected to its host computer as comprising a "network," unless an actual wired or wireless network were actually implemented to enable their connection. Zintel neither teaches nor suggest use of such a network. Clearly, the Examiner is distorting the meaning of the word "network" in an effort to force the prior art to satisfy Applicant's claim language.

Regarding the "downloading" of XML information referenced by the Examiner on page 11, Applicant notes that XML is *not* a network protocol and its use does not somehow convert communications between Zintel's peripheral device and computer into network communications.

Finally, as Applicant acknowledged in the Appeal Brief, Butt does disclose downloading software from the Internet. Again, Applicant concedes that it is known to

download software from the Internet. However, it is *not* known to, as claimed by Applicant, download a device discovery plug in via a network. Applicant submits that the claim as a whole must be considered when evaluating the limitations of Applicant's claims. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987) (In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). Furthermore, Applicant reiterates that Zintel *teaches away* from downloading Zintel's "adapter" software from a network. Specifically, Zintel teaches downloading the adapter when a peripheral device first connects to a host in a plug-n-play arrangement. To modify Zintel's invention and require the user to download the adapter from a network site such as a web site would disable a key aspect of Zintel's invention. In Zintel's invention, the adapter software is *automatically* downloaded to Zintel's host computer upon connecting the peripheral device to the computer, thereby enabling the "auto-configuring" process that is a primary goal of Zintel's invention. *See Zintel*, Patent Title and Abstract.

B.   Downloading a "Device Discovery Plug In"

Regarding Applicant's points as to Zintel's failure to teach or suggest "downloading a device discovery plug in via a network using a network browser", the Examiner points to column 3, lines 17-25 of the Zintel reference. The paragraph upon which the Examiner relies provides as follows:

According to a further aspect of the invention, the adapter is automatically installed and configured for a peripheral device by host operating software along with device-specific driver software upon connecting or "plugging" the peripheral device into the host, for example, as part of a "plug-and-play" peripheral device installation sequence. At the time of connecting the peripheral device into the host or during a boot-up sequence of the host operating software, the host operating software detects that a new peripheral device has been connected; and automatically selects or prompts the user to select and then installs an appropriate device driver for the new peripheral device. The host operating software also automatically installs a peer networking-to-host/peripheral adapter, which exposes the peripheral to control from peer networking devices that are networked to the host and optionally permits control of peer networking devices from the peripheral.

Zintel, column 3, lines 9-25.

In above excerpt, Zintel describes: (i) a peripheral device being connected to a host computer, (ii) the host computer detecting the peripheral device, and (iii) the host computer installing a device driver and a peer networking-to-host/peripheral adapter for the peripheral device. In view of that, Applicant asks: How does that teach or suggest "downloading a device discovery plug in via a network using a network browser"? First, no "network" or "network browser" is described as being used by Zintel. Second, Zintel only describes downloading of a "device driver" and a "peer networking-to-host/peripheral adapter for the peripheral device," neither of which are described in the excerpt as being capable of "discovering" a peripheral device. Ostensibly, the Examiner believes that Zintel's mere description of "detecting" the connected peripheral equates to "downloading a device discovery plug in via a network using a network browser".

Applicant fails to understand this logic. Specifically, Zintel does not describe in column 3 downloading software, whether you call it a "plug in" or an "adapter," that functions to discover peripheral devices. Furthermore, the downloading of Zintel's "adapter" occurs *after* Zintel's computer detected the peripheral device. If Zintel had described that the detection of the peripheral device resulted from the download of software that identifies such peripheral devices, Applicant could see the Examiner's point. As it stands, however, Zintel provides no such teaching. Missing is a teaching or suggestion of sending a computer software that determines what peripheral devices are connected to that computer.

For the first time during prosecution of the instant application, the Examiner directs the Applicant's attention to column 46, lines 33+ of the Zintel reference. *Examiner's Answer*, page 12. That portion of Zintel's disclosure provides as follows:

> UPnP implements a peer discovery mechanism that uses the Simple Service Discovery Protocol (SSDP) for discovery of devices on IP networks. SSDP is based on profiles. A single identifier specifies a profile that defines a contract between the client and service (e.g., operational functions provided by the embedded computing device). By identifying itself with the profile, the service advertises compliance with the associated contract. Using a single identifier makes it possible to implement an extremely simple discovery system. Clients send out a User Datagram Protocol (UDP) multicast packet containing the identifier of the desired service on some standard channel. Services listen on the standard channel, read the request, see whether they provide the service, and respond if so.

Zintel, column 46, lines 33-46. As a first matter, Applicant notes that the above excerpt has nothing to do with the detection of a peripheral device or the downloading of software for that peripheral device described in Zintel's column 3. Furthermore, Applicant notes that the Examiner fails to make a connection between the two teachings. Therefore, it is difficult to understand how the Examiner believes that Zintel teaches "downloading a device discovery plug in via a network using a network browser". Specifically, it is unclear whether the Examiner believes that the detection of the connected peripheral device described in column 3 accounts for Applicant's claimed "discovery" or whether it is some process performed by the UPnP described in column 46 that accounts for that action. Applicant submits that the ambiguity created by the new reliance upon the teachings of column 46 coupled with the continued reliance on the teachings of column 3 renders it nearly impossible for the Applicant to follow the Examiner's logic and provide an appropriate response. Therefore, the Examiner is denying Applicant a full and fair hearing on the issue of patentability of Applicant's claims. As provided in MPEP 706.07, "[t]he Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal."

Regardless of the ambiguity of the rejection, the "UPnP protocol" described by Zintel is the protocol used by the peer networking-to-host/peripheral adapter to enable peer-to-peer communication between the peripheral device connected to Zintel's host computer and another peripheral device. As described by Zintel in the above excerpt, the UPnP protocol enables the discovery of the other peripheral devices. However, such discovery still does not equate to the action of "downloading a device discovery

-8-

plug in via a network using a network browser". Again, *not* described is downloading "via a network using a network browser" software that can discover peripheral devices. Applicant further notes that the Examiner has yet to make any attempt to identify any "network browser" in relation to the Zintel reference.

As a final note, regarding the Examiner's identification of Zintel's statement that "Devices can be networked instead of being attached directly to a PC, and devices are all autonomous citizens on the network, able to talk with each other and exchange information" in column 47, Applicant notes that such a teaching actually weakens the Examiner's case. Specifically, if Zintel's peripheral device is not connected to a host computer and instead operates as an "autonomous citizen" on the network, then there would be no software to be downloaded from the peripheral device to the host computer and no "downloading a device discovery plug in" as required by Applicant's claims.

C. Claim 30

Regarding claim 30, the Examiner dismisses Applicant's assertion that neither reference teaches or suggests transmitting data "describing peripheral devices" to a "vendor website" because Applicant's statement allegedly amounts to "a general allegation that the claims define a patent invention without specifically pointing out how the language of the claims patentably distinguishes then from the references." *Examiner's Answer*, page 13. In reply, Applicant notes that the Examiner provided no more detail in rejecting claim 30:

Referencing claim 30, as closely interpreted by the Examiner, Zintel teaches transmitting data describing peripheral devices comprises [*sic*] transmitting the data to a vendor website, (e.g., col. 8, line 54-col. 9, line 5).
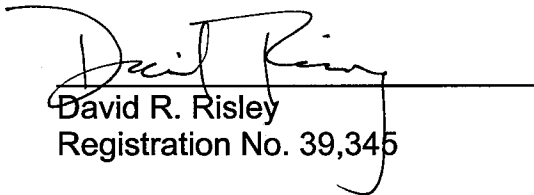
Examiner's Answer, page 6. As can be appreciated from the above excerpt, the Examiner, as with all the claims, rejects claim 30 by merely block-copying language from Applicant's claims and providing a citation to a portion of a prior art reference. Therefore, Applicant submits that it is the Examiner who has not satisfied *his* burden in presenting a *prima facie* case of obviousness under 35 U.S.C. § 103. In particular, the Examiner provides no explanation whatsoever of *how* the identified portions of the references teach or suggest Applicant's claim limitations.

Regardless, Applicant stands behind its previous statement that neither of the references teaches or suggests transmitting data describing peripheral devices to a "vendor website". As for column 8, line 54 to column 9, line 5 of the Zintel reference, that excerpt says *nothing* of a "website", much less a "vendor website". Applicant knows of no other way of proving a negative but to say what is not described in the reference and request that the Board verify the absence of that description.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

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